

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed November 21, 2008. At the time of the Office Action, Claims 1, 3, 4, 7-10, 13, 14, and 37-45 were pending in this Application. Claims 1, 3, 4, 7-10, 13, 14, 37-45 were rejected. Claims 2, 5 and 6 were previously cancelled without prejudice or disclaimer and Claims 11, 12 and 15-36 were previously cancelled due to an election/restriction requirement. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §103

Claims 1, 3, 4, 7-10, 13, 14, and 37-45 were rejected under 35 U.S.C. §103(a) as being unpatentable over “High Surface Area Substrates for DNA Arrays” *Materials Research Society Symposium Proceedings*, p. 371-376, by M. Glazer et al. (“Glazer”) and U.S. Patent No. 5,629,186 issued to Robert D. Yasukawa et al. (“Yasukawa”), and further in view of PCT Publication No. WO 96/24631 by Mark Lyles (“Lyles”).

Claims 1, 3, 4, 7-10, 13, 14, and 37-45 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,959,098 issued to Martin Goldberg et al. (“Goldberg”) and Yasukawa and Lyles. Applicant respectfully traverses and submits that the cited art combinations, even if proper, which Applicant does not concede, do not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

In response to the prior Office Action, Applicants argued that the asserted references fail to disclose the claimed mean pore diameter. In response to those arguments, the Examiner asserts that Yasukawa discloses a material having a mean pore diameter of greater than 10 microns as is currently claims. This is simply not true. The mean pore diameter, although not defined in the application, has a plain meaning that requires that the measurement represent the mean measurement for all pores in the material, *i.e.* the average pore diameter. Measurements for individual pores or diameters of only one portion of a pore are not the same as the mean pore diameter.

The portion of Yasukawa cited by the Examiner relates to individual pore measurements, not mean measurements. Specifically, the pore dimensions recited in Cols. 3 and 4 relate only to the range of dimensions, not the mean dimension: “3-dimensionally continuous network of interconnecting void or pores, such a voids 31, which tend to have ‘long’ (uninterrupted) dimensions ***between about 10-100 μ m.***” (Col. 4, lines 9-13, emphasis added.) The identification of this dimension as the “long” dimension clearly implies that there are shorter

dimensions of the pores and thus that the mean pore diameter is less than the dimension of the “long” dimension. Yasukawa provides no way to determine what this mean pore diameter might actually be.

The examiner also cites a portion of Yasukawa discussing the ability to adjust the slurry to achieve different pore sizes. (Col. 2, lines 16+). This portion of Yasukawa says nothing about achieving any particular pore size. Accordingly, it does not teach or suggest a mean pore size of 10 microns or greater.

Yasukawa accordingly fails to teach or suggest the claimed mean pore diameter. The Examiner does not rely on any other reference to teach this claim element. Withdrawal of all rejections under 35 U.S.C. §103 is requested.

CONCLUSION

Applicant has now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of all claims.

Applicant believes no fees are due at this time. The Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P. in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2580.

Respectfully submitted,
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